

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 2693944

Registered on March 4, 2003

For the Mark of a Stylized Design

EARTHLITE MASSAGE TABLES, INC.)

Petitioner,)

v.)

LIFEGEAR, INC.)

Registrant.)

Cancellation No. 92045166

**EARTHLITE MASSAGE TABLES, INC.'S
REPLY TO OPPOSITION TO
MOTION TO SUSPEND PROCEEDINGS**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

The Petitioner, Earthlite Massage Tables, Inc., (hereinafter "EARTHLITE"),
respectfully submits the following Reply to Lifegear Inc.'s (hereinafter "LIFEGEAR")
Opposition to the Motion to Suspend Proceedings herein:



03-29-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #33

I.

**EARTHLITE REQUESTED A STIPULATION FROM LIFEGEAR TO SUSPEND THE
TTAB PROCEEDINGS ONE WEEK PRIOR TO THE FILING OF LIFEGEAR'S
MOTION FOR STAY IN THE CIVIL ACTION.**

On or about January 25, 2006, counsel for EARTHLITE left a detailed voice message for counsel for LIFEGEAR that EARTHLITE intended to file the instant Motion to Suspend Proceedings in the TTAB action, and requested that LIFEGEAR sign a stipulation to suspend the proceedings. (Declaration of James P. Broder, ¶ 2). Not so coincidentally, nine days later, on February 3, 2006, LIFEGEAR filed its Motion for Stay of Proceedings in the Civil Action. During this nine-day period, counsel for LIFEGEAR never communicated to EARTHLITE that he would not stipulate to suspend the TTAB proceedings until this impliedly became clear from LIFEGEAR's filing of its motion in the Civil Action. (Declaration of James P. Broder, ¶ 3). Moreover, LIFEGEAR's motion in the Civil Action was filed three months after the TTAB proceedings were initiated by EARTHLITE, which is inconsistent with LIFEGEAR's position that staying the Civil Action will somehow expedite the ultimate resolution of this case.

LIFEGEAR would have the TTAB believe it was LIFEGEAR that initiated the concept of staying the proceedings in the Civil Action, and that EARTHLITE followed suit by filing a "duplicative" motion with the TTAB. In fact, the opposite is true. EARTHLITE tried to cooperate with counsel for LIFEGEAR by seeking a stipulation to suspend the TTAB proceedings so that the parties could concentrate on all of the issues in the Civil Action only. LIFEGEAR instead chose to silently, and without warning to

counsel for EARTHLITE herein, race to the District Court to file its motion. The chronology of events described above is illustrative of LIFEGEAR's forum jockeying.

It is true that EARTHLITE filed the instant action before the TTAB and has now moved to suspend the proceedings. The rationale of this course of action is sound because EARTHLITE wanted to preserve its right to seek cancellation of the LIFEGEAR marks, while also preempting any laches argument by LIFEGEAR in the event EARTHLITE had waited to file the TTAB action.

Despite the law being very clear that the District Court is not bound to any decision by the TTAB, LIFEGEAR would seemingly rather have one of the numerous issues in the Civil Action adjudicated by the TTAB, leaving the remaining issues to be later resolved by the District Court. As explained below, this is an inefficient use of resources, particularly with no guarantee that the decision of the TTAB will be followed by the District Court.

II.

EXTENSIVE DISCOVERY HAS ALREADY BEEN PERFORMED IN THE CIVIL ACTION.

EARTHLITE and LIFEGEAR are actively engaged in protracted discovery in the Civil Action as both parties have exchanged literally hundreds of written discovery responses relating to the specific issues being litigated in the Civil Action. Additionally, thousands of documents have been produced. Key witness depositions are in the process of being scheduled. This discovery may or may not relate to the specific issue

in the TTAB proceedings. The discovery cutoff is rapidly approaching, and trial is currently set for December 18, 2006.

Further, EARTHLITE has already commissioned and completed – at considerable cost – a trademark survey demonstrating substantial “actual” confusion between the respective trademarks at issue in the Civil Action. If the TTAB does not defer to the District Court by suspending the instant TTAB proceedings, EARTHLITE will be substantially prejudiced because LIFEGEAR continues to manufacture, market and sell its offending products throughout the United States.

III.

THE DECISION TO SUSPEND THE TTAB PROCEEDINGS IS INDEPENDENT OF THE DISTRICT COURT’S DECISION.

Despite LIFEGEAR’s lengthy discussion of the decision by one District Court in the Citicasters Co. v. Country Club Communications, 44 U.S.P.Q. 2d 1223 (C.D. Cal. 1997), the TTAB is not handcuffed by the pending motion in the Civil Action. The decision in Citicasters simply provides that the District Court can decide whether or not it wants to stay a case to control its docket. However, Citicasters does not hold that the TTAB is powerless to suspend a cancellation action upon a motion properly being filed by one of the parties to the TTAB action. The court in Citicasters did not reach the conclusion that the TTAB must take a backseat and defer to the District Court when similar motions are filed in both forums. In summary, the TTAB has the authority to suspend the instant proceedings and await the outcome of the Civil Action, which will be dispositive of the issues now before the TTAB.

IV.

CONCLUSION

Based on the foregoing, Petitioner, Earthlite Massage Tables, Inc. hereby respectfully requests that the instant Motion to Suspend Proceedings be granted, and that the Cancellation Proceedings herein be suspended pending the outcome of the related civil action, *Earthlite Massage Tables, Inc. v. Lifegear, Inc. d/b/a Earthgear, et al.*, United States District Court Case No. 05 CV 0667 DMS (AJB).

Dated: March 27, 2006

Respectfully submitted,

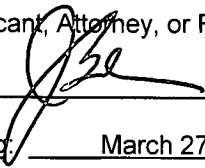


JAMES P. BRODER
THE LAW OFFICE OF STEVEN G. ROEDER
Registration No. 43,514
Attorney for Petitioner,
EARTHLITE MASSAGE TABLES, INC.

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to United States Patent And Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451, on this 27th day of March, 2006.

Name of Applicant, Attorney, or Representative certifying mailing: James P. Broder

Signature: 

Date of Signing: March 27, 2006

I also hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Daniel Cislo, Esq., CISLO & THOMAS, LLP, 233 Wilshire Blvd., Ste. 900, Santa Monica, CA 90401, on this 27th day of March, 2006.

Name of Applicant, Attorney, or Representative certifying mailing: James P. Broder

Signature: 

Date of Signing: March 27, 2006

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_____)	
EARTHLITE MESSAGE TABLES, INC.)	
)	
)	
Petitioner,)	Cancellation No. 92045166
)	
v.)	DECLARATION OF JAMES P. BRODER
)	
LIFEGEAR, INC.)	
)	
)	
Registrant.)	
_____)	

I, James P. Broder declare as follows:

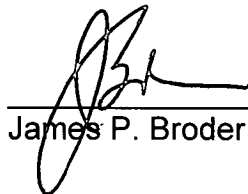
1. That I am an attorney duly licensed and registered before the United States Patent and Trademark Office, and that I am an attorney of record for Earthlite Massage Tables, Inc. in the instant cancellation proceedings. I have knowledge of the facts and circumstances contained herein, and if called as a witness, could and would competently testify thereto.

2. On or about January 25, 2006, I left a voicemail message for attorney Kelly Cunningham at his office, specifically requesting that Mr. Cunningham stipulate and agree to a suspension of the proceedings in the instant cancellation action.

3. At no time before February 3, 2006, when the Motion for Stay of Proceedings in the Civil Action was filed, did I ever receive an indication from Mr. Cunningham that he would not stipulate to the requested suspension of proceedings in the instant cancellation matter.

I declare that the facts set forth in this declaration are true; and that all statements made on my own knowledge are true and all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code.

Executed on this 27th day of March, 2006, in San Diego, California.



James P. Broder